

4-14-05

84652

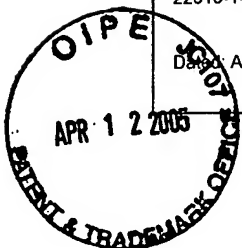
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EL 984096739 US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

PATENT
Docket No. 300622000508

Date: April 12, 2005

Signature:

(Rhonda L. Mason)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Chaitan KHOSLA et al.

Serial No.: 10/727,696

Filing Date: December 3, 2003

For: COMBINATORIAL POLYKETIDE
LIBRARIES PRODUCED USING A
MODULAR PKS GENE CLUSTER AS
SCAFFOLD

Examiner: Not Yet Assigned

Group Art Unit: 1652

**INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of the documents numbered 23, 25, and 27 are submitted herewith. However, copies of the remaining documents cited in the attached Form PTO/SB/08a/b were previously submitted in an Information Disclosure Statement and/or Office Action, directed to the related application Serial Number 10/096,790, filed March 12, 2002, and, accordingly, copies are not included herewith. This protocol conforms with 37 C.F.R. § 1.98(d) and M.P.E.P. 609(A)(2). The Examiner is requested to make these documents of record in the application.

sd-238639

This application is a Continuation of United States Serial Number 10/096,790, filed March 12, 2002, which is a Continuation of United States Serial Number 08/846,247, filed April 30, 1997, now United States Patent Number 6,391,594.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of __ is enclosed.
 - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of __ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

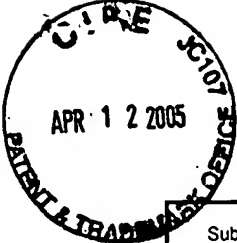
The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 300622000508. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: April 12, 2005

Respectfully submitted,

By Brenda J. Wallach
Brenda J. Wallach
Registration No.: 45,193
MORRISON & FOERSTER LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130
(858) 720-7961



Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>			Complete if Known		
			Application Number	10/727,696	
			Filing Date	December 3, 2003	
			First Named Inventor	Chaitan KHOSLA	
			Art Unit	1652	
			Examiner Name	Not Yet Assigned	
Sheet	1	of	2	Attorney Docket Number	300622000508

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
	1.	US-2002/0192756	12-19-2002	DANIEL SANTI	
	2.	US-2003/0124680	07-03-2003	CHRISTOPHER REEVES	
	3.	US-5,672,491	09-30-1997	CHAITAN KHOSLA	
	4.	US-5,712,146	01-27-1998	CHAITAN KHOSLA	
	5.	US-5,824,513	10-20-1998	LEONARD KATZ	
	6.	US-5,876,991	03-02-1999	BRADLEY S. DEHOFF	
	7.	US-5,945,320	08-31-1999	STANLEY G. BURGETT	
	8.	US-5,962,290	10-05-1999	CHAITAN KHOSLA	
	9.	US-6,004,787	12-21-1999	LEONARD KATZ	
	10.	US-6,060,234	05-19-2000	LEONARD KATZ	
	11.	US-6,063,561	05-16-2000	LEONARD KATZ	
	12.	US-6,066,721	05-23-2000	CHAITAN KHOSLA	
	13.	US-6,080,555	06-27-2000	CHAITAN KHOSLA	
	14.	US-6,200,813	03-13-2001	LEONARD KATZ	
	15.	US-6,271,255	08-07-2001	PETER FRANCIS LEADLAY	
	16.	US-6,391,594	05-21-2002	CHAITAN KHOSLA	
	17.	US-6,399,789	06-04-2002	DANIEL SANTI	
	18.	US-6,403,775	06-11-2002	ROBERT MCDANIEL	
	19.	US-6,500,960	12-31-2002	CHAITAN KHOSLA	
	20.	US-6,558,942	05-06-2003	CHAITAN KHOSLA	

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				
	21.	WO-98/01546	01-15-1998	PETER FRANCIS LEADLAY		
	22.	WO-98/01571	01-15-1998	PETER FRANCIS LEADLAY		
	23.	WO-02/14482	02-21-2002	HRVOJE PETKOVIC		

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	24.	KUHSTOSS et al., Gene (1996) 183:231-236	
	25.	MCDANIEL et al., PNAS USA (1999) 96:1846-1851	
	26.	OLIYNYK, Chem. & Biol. (1996) 3:833-839	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

sd-238635

Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				Complete if Known	
				Application Number	10/727,696
				Filing Date	December 3, 2003
				First Named Inventor	Chaitan KHOSLA
				Art Unit	1652
				Examiner Name	Not Yet Assigned
Sheet	2	of	2	Attorney Docket Number	300622000508

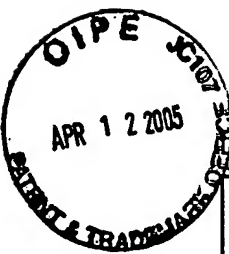
27.	REEVES et al., Biochemistry (2001) 40:15464-15470	
-----	---	--

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

sd-238635



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/727,696	
	Filing Date	December 3, 2003	
	First Named Inventor	Chaitan KHOSLA	
	Art Unit	1652	
	Examiner Name	Not Yet Assigned	
Total Number of Pages in This Submission	8	Attorney Docket Number	300622000508

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement (3 Pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Form PTO/SB/08a/b (2 pages) + duplicate 3 References Return Receipt Postcard
<div>Remarks</div> <p>Customer No. 25225</p>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP		
Signature	<i>Brenda J. Wallach</i>		
Printed name	Brenda J. Wallach		
Date	April 12, 2005	Reg. No.	45,193

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EL 984096739 US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.	
Dated: April 12, 2005	Signature: <i>Brenda L. Mason</i> (Brenda L. Mason)